

### REMARKS

In response to the Office Action mailed on October 18, 2006, Applicants respectfully request reconsideration based on the above claim amendments and the following remarks. Applicants respectfully submit that the claims as presented are in condition for allowance.

Claims 1, 10, 22 and 25 have been amended, leaving Claims 1-25 for consideration upon entry of the present amendment. No new matter has been added by the amendments.

#### Support for Claim Amendments

Support for the amendments can be found in Applicants' specification. See, for example, paragraph [0023] in Applicants' specification.

#### Claim Rejections Under 35 U.S.C. § 101

Claim 25 stands rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. In particular, the Examiner states that Claim 25 contains a "computer program product" that is a "signal" and thus non-statutory under the Interim Guidelines for Examination of Patent Applications for Patentable Subject Matter Eligibility. Applicants respectfully traverse the rejection of Claim 25 under 35 U.S.C. § 101.

35 U.S.C. § 101 reads: "Whoever invents or discovers any new and useful process, machine, *manufacture*, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title" (emphasis added). Claims directed to a "manufacture" (e.g., memory, computer-readable medium) having instructions stored in or on it for causing steps to be performed when the instructions are executed are proper statutory subject matter. Such claims are directed to a manufacture. (*Overview of Interim Guidelines for Subject Matter Eligibility*, [http://www.uspto.gov/web/offices/pac/compexam/interim\\_guide\\_subj\\_matter\\_eligibility.html](http://www.uspto.gov/web/offices/pac/compexam/interim_guide_subj_matter_eligibility.html); see also, *In re Beauregard*, 53 F.3d 1583 (Fed. Cir. 1995)).

Applicants are not claiming "a signal" as indicated by the Examiner. Rather, the preamble of Claim 25 as amended recites, *inter alia*, "a *storage medium* encoded with machine readable computer program code...the storage medium *including instructions* for causing a

server to implement a method.” Thus, as recited, Claim 25 is directed to the statutory class of a “manufacture” and is believed to be fully compliant with the requirements set forth in 35 U.S.C. 101.

In addition, Applicants have amended Claim 25 to include the element “a computer-readable storage medium storing instructions for executing the no-ring telephone call service” as suggested by the Examiner.

Applicants submit that Claim 25 is in condition for allowance and request the Examiner to withdraw the rejection.

**Claim Rejections Under 35 U.S.C. § 103(a)**

Claims 1-5 and 7-25 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,215,857 to Kasiviswanathan (hereinafter “Kasiv”), in view of U.S. Patent No. 6,600,817 to Shaffer et al. (hereinafter “Shaffer”). Applicants respectfully traverse the rejection because all of the elements in Claims 1-5 and 7-25 are not taught or suggested by Kasiv in view of Shaffer.

Claim 1, as amended, recites: “A method for providing a no-ring telephone call service, the method comprising: receiving notification that a telephone call from a calling party device requesting to use the no-ring telephone call service has arrived at a switch, the notification including a called party telephone number; and determining if the called party telephone number corresponds to a voice mail platform telephone number in a region wide messaging database, wherein: when the called party telephone number corresponds to a voice mail platform telephone number, instructions to route the telephone call to the voice mail platform telephone number are communicated to the switch; when the called party telephone number does not correspond to a voice mail platform telephone number and the calling party device is utilizing the no-ring telephone call service, instructions to play a pre-recorded message are communicated to the switch, the pre-recorded message including a direct connect option for completing the telephone call to the called party telephone number including ringing a device at the called party telephone number; and when the calling party device selects the direct connect

option, the no-ring telephone call application sends instructions to the switch to complete the telephone call.” (Emphasis added.)

Kasiv is directed to enabling a calling subscriber to invoke the forwarding of a call to a voice mail system for the called subscriber on a call-by-call basis in order to leave a message for the called subscriber without disturbing (ringing) the called subscriber. (Kasiv; Abstract.) If voice mail is either not assigned to the called subscriber or the voice mail of the called subscriber is inactive, the call is torn down without being set up. (Kasiv; Col. 4, lines 61-65.) Kasiv also teaches that the called subscriber may inhibit direct access to their voice mail by the calling subscriber. (Kasiv; Abstract.)

Shaffer is directed to a system for monitoring incoming calls to a target communication terminal during a predetermined time period so as to prevent calls placed at undesirable times from being automatically connected to the target communication terminal. When the system detects an incoming call during the predetermined time period it plays a message informing the caller of the local time of the target communication terminal, plays a message indicating that the call has been received during a predetermined time period in which calls are being monitored, and offers the caller the option of abandoning the call before it is connected. If the caller takes the option of abandoning the call, then call is disconnected. Alternatively, if the caller does not take the option of abandoning the call, the call is connected to the target communication terminal. (Shaffer; Abstract.)

The Examiner looks to Kasiv for teaching the elements “receiving notification that a telephone call from a calling party device requesting to use the no-ring telephone call service has arrived at a switch, the notification including a called party telephone number; and determining if the called party telephone number corresponds to a voice mail platform telephone number in a region wide messaging database, wherein: when the called party telephone number corresponds to a voice mail platform telephone number, instructions to route the telephone call to the voice mail platform telephone number are communicated to the switch; when the called party telephone number does not correspond to a voice mail platform telephone number and the calling party device is utilizing the no-ring telephone call service, instructions to play a pre-recorded message are communicated to the switch” as recited in Claim 1. Applicants disagree with the

Examiner because Kasiv requires that the called party be a “subscriber”. This allows the called party to disable access by the calling party to the called party’s voice mail. Claim 1 recites no such constraint on the called party telephone number or called party device. Thus, Kasiv does not teach or suggest all of the elements of Claim 1. The addition of Shaffer does not cure this deficiency in Kasiv.

In addition, the Examiner looks to Shaffer for teaching “when the called party telephone number does not correspond to a voice mail platform telephone number and the calling party device is utilizing the no-ring telephone call service, instructions to play a pre-recorded message are communicated to the switch, the pre-recorded message including a direct connect option for completing the telephone call to the called party telephone number including ringing a device at the called party telephone number; and when the calling party device selects the direct connect option, the no-ring telephone call application sends instructions to the switch to complete the telephone call” as recited in amended Claim 1.

Applicants submit that Shaffer does not teach at least the element “play a pre-recorded message ... including a direct connect option when the called party telephone number does not correspond to a voice mail platform telephone number and the calling party device is utilizing the no-ring telephone call service” as recited in Claim 1. In contrast, as described above, Shaffer plays the message and gives the caller the option of connecting the call based on parameters set by the target communication terminal. Shaffer is not concerned with conditions having to do with the calling party device. In Shaffer, the user of the target communication terminal selects the parameters (e.g., time period, time zones of calling parties) that control when the message will be played to the calling party. This is not the same as “play a pre-recorded message ... including a direct connect option when the called party telephone number does not correspond to a voice mail platform telephone number and the calling party device is utilizing the no-ring telephone call service” as recited in Claim 1.

Therefore, neither Kasiv nor Shaffer, alone or in combination, teaches or suggests all of the elements of Claim 1. Applicants submit that Claim 1 is patentable over Kasiv in view of Shaffer. Claims 2-5 and 7-9 depend from Claim 1 and are patentable at least due to their dependency on Claim 1. Claims 10, 22, and 25 include similar elements as Claim 1 and are

patentable for at least the same reasons that Claim 1 is patentable. Claims 11-21 depend from Claim 10 and are patentable at least due to their dependency on Claim 10. Claims 23-24 depend from Claim 22 and are patentable at least due to their dependency on Claim 22.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kasiv, in view of Shaffer, and further in view of U.S. Patent No. 5,181,238 to Medamana et al. (hereinafter "Medamana"). Applicants respectfully traverse the rejection because all of the elements in Claim 6 are not taught or suggested by Kasiv and Shaffer in view of Medamana.

As stated above, neither Kasiv nor Shaffer, alone or in combination, teach or suggest the elements "play a pre-recorded message ... including a direct connect option when the called party telephone number does not correspond to a voice mail platform telephone number and the calling party device is utilizing the no-ring telephone call service" as recited in Claim 1. The addition of Medamana does not cure this deficiency in Kasiv in view of Shaffer.

Madamana is directed to arrangements for providing pre-authenticated access from a caller to a service provider. The caller dials the number of the service provider and subsequently enters a personal identification number (PIN) or other suitable authentication data, and if necessary, an account number. A data base in the communications carrier verifies that the caller has been authorized to access the service provider and that the PIN is correct for that caller and forwards the call to the service provider only if both checks are satisfied. (Madamana; Abstract.) Madmana fails to teach or suggest at least the elements "play a pre-recorded message ... including a direct connect option when the called party telephone number does not correspond to a voice mail platform telephone number and the calling party device is utilizing the no-ring telephone call service" as recited in Claim 1. Therefore, Madamana does not cure the deficiencies of Kasiv and Shaffer with respect to Claim 1. Accordingly, neither Kasiv nor Shaffer nor Madamana, alone or in combination, teaches or suggests all of the elements of Claim 1. Applicants submit that Claim 6 is allowable at least due to its dependency on Claim 1.

### Conclusion

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In view of the foregoing remarks and amendments, Applicants submit that the above-identified application is now in condition for allowance. Early notification to this effect is respectfully requested.

If any issues remain, the Examiner is invited to contact the undersigned at the telephone number below.

No new matter has been entered and no additional fees are believed to be required. If there are any charges with respect to this response or otherwise, please charge them to Deposit Account 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

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